APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
CHANG, JON CARLTON

ART UNIT	PAPER NUMBER
2623	6

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/761,249	LE MAGUET, YANN
	Examiner	Art Unit
	Jon Chang	2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1,3 and 5* is/are allowed.

6)☒ Claim(s) *2,4 and 6* is/are rejected.

7)☐ Claim(s) ____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 January 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

Claim Objections

1.   Claims 1-4 are objected to because of the following informalities:

In claim 1, at line 9, the claims read, "characterized in that it comprises."

Reference to the term "it" is somewhat vague. See also claims 2, 3 and 4.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   Claims 2 and 4 are rejected under 35 U.S.C. 102(a) as being anticipated by PCT

publication WO 99/51033 to Bailleul (hererinafter "Beilleul").

As to claim 2, Bailleul discloses a method of modifying data in an encoded data

signal comprising:

a) a decoding step for decoding said encoded data signal and providing a decoded data

signal (Fig.5, the IDCT which outputs R'(n,1)),

b) a re-encoding step performed on a modified data signal and generating a coding

error (Fig.5, blocks including and after the DCT, the coding error is e(n,2)),

c) a prediction step for providing a motion-compensated signal from said coding error

and comprising at least a subtracting sub-step between an input data signal obtained at

least from said decoded data signal and said motion-compensated signal for obtaining

said modified data signal (Fig.5, blocks including MEM and COMP, and the subtraction

occurring on the output of the COMP block),

characterized in that it comprises a sub-step for adding an additional data signal to said

modified data signal, before said re-encoding step (the adding of the additional data

occurs at the A circle, which is before the re-encoding).

As to claim 4, Bailleul discloses a transcoding device for adding data to an

encoded data signal, comprising

a) decoding means for decoding said encoded data signal and providing a decoded

data signal (Fig.5, the IDCT which outputs R'(n,1)),

b) re-encoding means acting on a modified data signal and generating a coding error

(Fig.5, blocks including and after the DCT, the coding error is e(n,2),

c) prediction means for providing a motion-compensated signal from said coding error

and comprising at least subtracting means acting on an input data signal obtained at

least from said decoded data signal and said motion-compensated signal for obtaining

said modified data signal (Fig.5, blocks including MEM and COMP, and the subtraction

occurring on the output of the COMP block),

characterized in that it comprises means for adding an additional data signal to said

modified data signal, before the re-encoding means (the adding of the additional data

occurs at the A circle, which is before the re-encoding).

4.   Claims 2 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent 6,181,743 to Bailleul (hereinafter "Bailleul '743") or U.S. Patent 6,493,389 to

Bailleul (hereinafter "Bailleul '389").

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art

under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome

either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

the reference was derived from the inventor of this application and is thus not the

invention "by another," or by an appropriate showing under 37 CFR 1.131.

As to claim 2, Baileul '743 or Bailleul '389 discloses a method of modifying data

in an encoded data signal comprising:

a) a decoding step for decoding said encoded data signal and providing a decoded data

signal (Fig.5, the IDCT which outputs $R'(n,1)$),

b) a re-encoding step performed on a modified data signal and generating a coding

error (Fig.5, blocks including and after the DCT, the coding error is $e(n,2)$),

c) a prediction step for providing a motion-compensated signal from said coding error

and comprising at least a subtracting sub-step between an input data signal obtained at

least from said decoded data signal and said motion-compensated signal for obtaining

said modified data signal (Fig.5, blocks including MEM and COMP, and the subtraction occurring on the output of the COMP block),

characterized in that it comprises a sub-step for adding an additional data signal to said modified data signal, before said re-encoding step (the adding of the additional data occurs at the A circle, which is before the re-encoding).

As to claim 4, Baileul '743 or Bailleul '389 discloses a transcoding device for adding data to an encoded data signal, comprising

a) decoding means for decoding said encoded data signal and providing a decoded data signal (Fig.5, the IDCT which outputs R'(n,1)),

b) re-encoding means acting on a modified data signal and generating a coding error (Fig.5, blocks including and after the DCT, the coding error is e(n,2),

c) prediction means for providing a motion-compensated signal from said coding error and comprising at least subtracting means acting on an input data signal obtained at least from said decoded data signal and said motion-compensated signal for obtaining said modified data signal (Fig.5, blocks including MEM and COMP, and the subtraction occurring on the output of the COMP block),

characterized in that it comprises means for adding an additional data signal to said modified data signal, before the re-encoding means (the adding of the additional data occurs at the A circle, which is before the re-encoding).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baileul.

With regard to claim 6, Baileul discloses the method of claim 2 (see discussion

above for claim 2), but does not disclose a computer program product for a transcoding

device for adding data to an encoded data signal, comprising a set of instructions which,

when loaded into said device, causes said device to carry out the method as claimed in

claim 2. The Examiner takes Official Notice that it is well known to utilize computer-

based systems for processing video data streams (of which Beilleul's invention is

concerned.). It would have been obvious to one of ordinary skill in the art to employ

such a computer-based system to implement Beilleul's method because of the flexibility

offered by computers, their widespread use, and their low cost. In utilizing a computer,

the computer program product would be inherent.

7.   Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baileul

'743 or Bailleul '389.

With regard to claim 6, Baileul '743 or Bailleul '389 discloses the method of claim

2 (see discussion above for claim 2), but does not disclose a computer program product

for a transcoding device for adding data to an encoded data signal, comprising a set of

instructions which, when loaded into said device, causes said device to carry out the

method as claimed in claim 2. The Examiner takes Official Notice that it is well known

to utilize computer-based systems for processing video data streams (of which Beilleul

'743's or Bailleul '389's invention is concerned.). It would have been obvious to one of

ordinary skill in the art to employ such a computer-based system to implement Beilleul

'743's or Bailleul '389's method because of the flexibility offered by computers, their

widespread use, and their low cost. In utilizing a computer, the computer program

product would be inherent.

Double Patenting

8.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11
F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225
USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA
1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,*
418 F.2d 528, 163 USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be
used to overcome an actual or provisional rejection based on a nonstatutory double
patenting ground provided the conflicting application or patent is shown to be commonly
owned with this application. See 37 CFR 1.130(b).
        Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

9.   Claim 2 is rejected under the judicially created doctrine of obviousness-type

double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,181,743.

Although the conflicting claims are not identical, they are not patentably distinct from

each other because claim 2 of the instant application covers the same subject matter as

claim 1 of the patent, but uses broader language.

Allowable Subject Matter

10.   Claims 1, 3 and 5 are allowed.

References Cited

11.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

U.S. Patent 6,226,041 to Florencio et al. discloses a method for logo insertion

into compressed digital video bitstreams.

U.S. Patent 6,373,530 to Birks et al. discloses a method for inserting logs into

digital video bit treams without having to completely decode and re-encode the

bitstreams.

U.S. Patent 6,594,311 to Pearlstein discloses a method which allows local

insertion of information into encoded video.

"A Method of Inserting Binary Data into MPEG Bitstreams" by Kiya et al. teaches

a method for inserting binary data into MPEG bitstreams.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon Chang whose telephone number is (703)305-8439. The examiner can normally be reached on M-F 8:00 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on (703)308-6604. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-4700.

Jon Chang
Primary Examiner
Art Unit 2623

Jon Chang
December 15, 2003